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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,089	07/28/2005	Hidehiko Yamagata	10921.343USWO	8591
52835 7590 04/07/2010 HAMRE, SCHUMANN, MUELLER & LARSON, P.C. P.O. BOX 2902 MINNEAPOLIS, MN 55402-0902				
EXAMINER				
JARRETT, LORE RAMILLANO				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
04/07/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/544,089

**Applicant(s)**

YAMAGATA ET AL.

**Examiner**

LORE JARRETT

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,5,7-10,12,13,15-18,20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-10,12,13,15-18,20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/28/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Status of Claims***

1. In applicant's reply filed on 12/7/09, applicant amended claims 1, 4-5, 7-10, 12-13, 15-18, 20, 22-24, and cancelled claims 2-3, 6, 11, 14, 19, 21, and 25-29. Claims 1, 4, 5, 7-10, 12-13, 15-18, 20, and 22-24 are pending and are under examination.

***Response to Amendment***

***Claim Objections***

2. The objection to claim 21 is withdrawn.

***Claim Rejections - 35 USC § 112***

3. The rejection of claims 1-25 under 35 U.S.C. 112, second paragraph, is withdrawn.

***Drawings***

4. The objection to the drawings under 37 CFR 1.83(a) is withdrawn.

***Claim Interpretation***

5. See paragraph 10 of the Office Action, filed on 7/7/09.

***Prior art rejections***

6. In light of applicant's amendments, the prior rejections are withdrawn. A new rejection follows.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1, 4, 5, 7-10, 12-13, 15-18, 20, and 22-24** are rejected under 35

U.S.C. 102(b) as being anticipated by Bonner et al. ("Bonner," US 5510266, previously applied).

As to claims 1 and 20, Bonner discloses an analytical testing feeder device comprising: a storage portion that stores a plurality of analytical testing elements (i.e. "that store" is intended use language; Office recommends, i.e., "comprising" to positively claim the analytical testing elements); a transporting member provided with at least one loading portion wherein an analytical testing element taken out from the storage portion is loaded, the transporting member transporting analytical testing elements one by one (i.e. language after "wherein" is intended use language); and a movable member attached to the storage portion; wherein the storage portion includes a plurality of storage spaces each storing a plurality of analytical testing elements (i.e. col. 5, line 29 to col. 6, line 49; 28, figs. 1-14). The last two paragraphs beginning with "wherein" in claim 1 is a recitation of the intended use of the claimed device. Because Bonner discloses the positively recited structural features, Bonner reads on the claimed intended use recitation.

As to claims 4, 8-10, 16, 23, and 24, these claims are considered statements of intended use, and therefore do not appear to positively recite structural features.

As to claim 5, Bonner discloses a rotating member (i.e. 26, figs. 1-14).

As to claims 7 and 22, Bonner discloses that her movable member includes at least one lift portion (i.e. any portion of 28) pivotable relative to the storage space, and

the rotating member includes a recess (i.e. 54, figs. 1-14) capable of performing the intended use.

As to claims 12 and 17, Bonner discloses first and second storage spaces and first and second lift portions (i.e. figs. 1-14).

As to claim 13, Bonner discloses a partition member in the storage portion that separates the first and second storage spaces (i.e. see figs. 1-14).

As to claim 15, Bonner discloses that her rotating member is capable of performing the intended use language, and a rotation controller (i.e. 84, figs. 1-14).

As to claim 18, Bonner discloses an actuator that is capable of performing the intended use language (i.e. 56, col. 5, lines 3-28).

### ***Response to Arguments***

9. Applicant's arguments filed 12/7/09 have been fully considered but they are not persuasive.

In response to applicant's argument that the pivot rod 28 of Bonner is not configured to lift any analytical testing elements away from a transporting member as in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, because Bonner reads on the positively recited structural features recited in claim 1, Bonner properly reads on the intended use language.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORE JARRETT whose telephone number is (571)272-7420. The examiner can normally be reached on Mon. to Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LORE JARRETT/  
Primary Examiner, Art Unit 1797

4/6/10